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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,475	10/16/2000	Richard A. Keeney	MGI-177	1423

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Barry R Lipsitz
755 Main Street
Bldg 8
Monroe, CT   06468

EXAMINER
TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">**Office Action Summary**</td><td>**Application No.**</td><td>**Applicant(s)**</td></tr>
<tr><td>09/688,475</td><td>KEENEY ET AL.</td></tr>
<tr><td></td><td>**Examiner**</td><td>**Art Unit**</td></tr>
<tr><td></td><td>Douglas Q. Tran</td><td>2624</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-90* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,5* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Drawings

1.   The drawings are objected to under 37 CFR 1.83(a) because the steps of the claimed

method are not shown. The drawings must show every feature of the invention specified in at

least of steps of the method claim 1. Therefore, the drawing of the independent claim 1 must be

shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.   Claims 1-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

For at least claims 1 and 46, " storing the print job at the spooling server" and "receiving

a polling request for the print job at the spooling server from a printer polling device " renders

the claims indefinite because of the following reasons:

1) the print job does not specify its command parameters to instruct the spooling server

how only to store the print job;

2) the print job does not specify its command parameters to instruct the spooling server

how for processing the document or image data included in the print job;

3) the print job does not specify its instruction parameters to instruct the spooling server

for transmitting the print job to the suitable printer or the user-desired printer in the network

based on the user command;

4) how the printer polling device knows the print job located at the spooling server in

order to request the print job; and

5) how the printer-polling device knows that the print job should be retrieved to the

printer-polling device without communicating with the user who generates the print job

including the print data and print commands.

6) the print job does not specify the instruction parameters included in the print job to

print the print data.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35-U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1-4, 6, 12-34, 39-45, 46-49, 51,57-79, 84-90 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Savitzky (US Patent No. 6,012,083).

As to claim 1, Savitzky teaches that a method of receiving, storing, and forwarding a

print job over a network, comprising:

forwarding the print job (i.e., document) to a spooling server (i.e., agency 32 in fig. 3);

receiving the print job at the spooling server(the proxy agent 36 in the agency 32 receiving the

document from the server A, col. 10, lines 26-27);

storing the print job at the spooling server (the document is stored into the queue as a

transaction when the document is received, col. 10, lines 40-41).

Receiving a polling request for the print job at the spooling server from a printer polling

device (i.e., client A is recipient who sends the document requests, col. 10, lines 33-34); and

Forwarding the requested print job from the spooling server to the printer-polling device

(client A is recipient who sends the document requests and receives the requested document, col.

10, lines 51-52).

Although Savitzky does not teach client A polling request the document to the spooling

server for printing, such limitation is merely a matter of design choice and would have been

obvious in the system of Savitzky. Savitzky discloses the printer agency (i.e., a printer polling

device) polling request the document to the connected server (14 in fig. 1) or other agent (30 in

fig. 2) for printing the document (col. 12, line 66 to col. 13, line 2). Therefore, to have the printer

polling device polling request the print job to the spooling server for retrieving and printing in

Savitzky would have been a matter of obvious design choice to one of ordinary skill in the art.

As to claim 2, Savitzky teaches that the print job is printed at a printer (62 in fig. 5)

coupled to the printer polling device (60 in fig. 5) (in this case, the printer agency 60 in fig. 5 is

the printer polling device for receiving the print job for printing at a printer 62, col. 12, line 66 to

col. 13, line 2).

As to claim 3, Savitzky teaches that the printer is located at a location remote from the

spooling server (see fig. 5).

As to claim 4, Savitzky teaches that the print job is forwarded to the spooling server

without a pre-determined print destination (with this condition, the print job is treated as a

document with a transferred document format 66 in fig. 5 without a command data for
instructing the printing at the suitable printer).

As to claim 6, Savitzky teaches that the network comprises: at least one of LANs, a
WAN, a global network, and the Internet (col. 1, lines 12-17).

As to claim 12, Savitzky teaches that the spooling server is capable of storing multiple
print jobs in at least one spooling queue (col. 6, line 28).

As to claim 13, Savitzky teaches that providing for encryption of the print job at a print
job source; and providing for decryption of the print job at the printer-polling device (col. 14,
lines 25-26).

As to claim 14, Savitzky teaches that the print job comprises a document provided by a
content provider (col. 10, lines 36-39).

As to claim 15, Savitzky teaches that the content provider is one of a newspaper, a
magazine, a periodical, a document provider, a graphic arts provider, a notification service, an
Internet content provider, a merchant, a financial institution, a government agency, or a shipping
company (66 in fig. 5, col. 49-52).

As to claim 16, Savitzky teaches that a single print job is provided by the content
provider for multiple users (12 in fig. 1).

As to claims 17-18, Savitzky teaches that the print job is provided by the content provider
on a subscription basis and a fee is charged to access the spooling server (i.e., the transaction,
col. 10, lines 39-42).

As to claim 19, Savitzky teaches that storing each print job at the spooling server
according to a personal identification number (PIN) (col. 12, lines 17-19).

As to claim 20, Savitzky teaches that communicating from the spooling server to the

printer polling device a list of print jobs associated with the PIN which are stored at the spooling

server; and providing for the selection of a print job (col. 12, lines 17-19).

As to claim 21, Savitzky teaches that storing a plurality of print jobs on the spooling

server according to the PIN (col. 12, lines 17-19).

As to claim 22, Savitzky teaches that the PIN is provided to the spooling server via one of

a user interface associated with the printer polling device, a telephone, a computer, an Internet

appliance, a facsimile machine, a scanner, a personal digital assistant device, or a dedicated

terminal; The list of available print jobs is displayed on one of a user interface associated with

the printer polling device, a telephone, a computer, an Internet appliance, a facsimile, a scanner,

a personal digital assistant device, or a dedicated terminal (table 1 in col. 6).

As to claim 23, Savitzky teaches that providing for designation of a desired print location

for the print job at a print job source; providing for communication of the desired print location

to the spooling server; printing the print job at the desired print location when the printer polling

device at the desired print location polls the spooling server and identifies the print job (see fig. 5

and col. 13, lines 1-2).

As to claims 24-26, Savitzky teaches that providing for designation of a substantially

specific time for printing a print job; making the print job available for printing from the

spooling server only at the designated substantially specific time; providing for a designated

lifetime of the print job, wherein the print job will be stored only for the designated lifetime;

providing for a designated number of printings of the print job, wherein the print job can only be

printed the designated number of times (the options which allow the clients control the print job).

As to claim 27, Savitzky teaches that the print job is one of a negotiable instrument, a stamp, a coupon, a certificate, a check, a unit of currency, a token, or a receipt (66 in fig. 5).

As to claim 28, Savitzky teaches that providing for the designation of one or more recipients of the print job, wherein the print job can only be printed by the designated one or more recipients (20 in fig. 1).

As to claim 29-33, Savitzky teaches that the printer polling device communicates printer status to the spooling server; the printer status comprises at least one of a printer ready indication, an online indication, toner level information, paper supply information, or error information; notifying a printer operator when the printer status indicates that the printer requires attention; providing the operator with vendor contact information to facilitate obtaining printer supplies or service; providing for automatic on line ordering of printer supplies as required by printer status (col. 13, lines 25-28).

As to claim 34, Savitzky teaches that the print job comprises at least one of a document, a poster (66 in fig. 5).

As to claim 39, Savitzky teaches that communications with the spooling server are enabled via at least one of a telephone, a personal digital assistant device, a computer, an Internet appliance, a web browser, or a dedicated terminal (18 in fig. 1).

As to claim 40, Savitzky teaches that providing a communication device for providing the status of the print job stored on the spooling server (col. 3, lines 58-64).

As to claim 41, Savitzky teaches that the status of the print job comprises at least one of

filename , file size, author, creation date, print job lifetime, image, title, contents, personal id,

recipient, job number, or reference number (col. 3, lines 45-52).

As to claim 42, Savitzky teaches that the communication device comprises one of a

telephone, a computer, an Internet appliance, a personal digital assistant device, or a dedicated

terminal (10 in fig. 1).

As to claim 43, Savitzky teaches that the print job source is one of a computer, a persona

digital assistant device, an Internet appliance, a facsimile, a scanner, a telephone, or a dedicated

terminal (12 in fig. 1).

As to claim 44, Savitzky teaches that the printer-polling device is capable of polling

multiple spooling servers (14 in fig. 1).

As to claim 45, Savitzky teaches that providing for the communication between the

spooling server (10 in fig. 1) and other servers (14 in fig. 1); and receiving a print job from at

least one of the other servers at the spooling server (col. 5, lines 6-8).

As to claims 46-49, 51,57-79, 84-90, Savitzky teaches the apparatus for performing the

method claims 1-4, 6, 12-34, 39-45 as indicated above.

6.   Claims 5, 35-38, 50 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable

over the combination of Savitzky and Newton et al. (US Patent No. 6,334,142 B1).

As to claim 5, Savitzky teaches every feature in claim 1 as indicated above.

However, Savitzky does not teach the printer polling device periodically polls the

spooling server to identify print jobs associated with the printer-polling device.

Newton, in the same field of endeavor, teaches the printer polling device periodically

polls the spooling server to identify print jobs associated with the printer polling device (col. 1,

lines 48-53).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the communication system of Savitzky for periodically polling the

spooling server to identify print jobs associated with the printer polling device as taught by

Newton. The suggestion for modifying the communication system of Savitzky can be reasoned

by one of ordinary skill in the art as set forth by Newton because Newton teaches communication

devices relates to supplying messages on the purpose of keep tracking documents on the network

by transmitting requests automatically at periodic intervals to the server from the first computer

for messages from another computer.

As to claims 35-37, Newton teaches that providing an agent program that provides a

directory of documents (the messages are stored on the server as files) to the spooling server, the

agent program enabling a client device associated with the print job source to poll the spooling

server to determine whether the spooling server requires a document from the directory to

complete a print job; and uploading the document from the client device to the spooling server.

Communicating the directory to the printer polling device; presenting the directory at the printer

polling device; providing for selection of a print job from the directory (col. 1, lines 43-53).

As to claim 38, Newton teaches that the client device periodically polls the spooling

server (col. 1, lines 48-53).

As to claims 50 and 80-83, combination of Savitzky and Newton teaches the apparatus

for performing the method claims 5, 35-38.

7.   Claims 7-11 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over

the combination of Savitzky and Pearson (US Patent No. 6,023,684).

As to claim 7, Savitzky teaches every feature in claim 1. Furthermore, Savitzky teaches

communication between any the computers (nodes) can occur on the Internet so long as both

computers are connected somewhere to the Internet which refers to a global internetwork of

networks (col. 1, lines 12-17).

However, Savitzky does not teach the printer polling device is located within a gateway

firewall; and the spooling server is located outside the gateway firewall.

Pearson, in the same field of endeavor, teaches the printer polling device (any of

computers in the network) is located within a gateway firewall; and the spooling server is located

outside the gateway firewall (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines

32-35).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the communication system of Savitzky in order to the printer

polling device is located within a gateway firewall; and the spooling server is located outside the

gateway firewall as taught by Pearson. The suggestion for modifying the system of Savitzky can

be reasoned by one of ordinary skill in the art as set forth by Pearson because Pearson provides a

security system in the network in which the documents of the users in the network are filtered by

a proxy firewall. The resultant system of Pearson would allow any document of Savitzky to be

maintained on the security system.

As to claim 8, Savitzky teaches that the print job is forwarded to the spooling server as web-style traffic and received at the printer-polling device as web-style traffic (see HTTP channels in fig. 1).

As to claim 9, Newton teaches that the print job is forwarded to the spooling server such that reconfiguration of the gateway firewall is not required (col. 6, lines 10-13).

As to claim 10, Savitzky teaches that a print job source is located at and in communication with a first LAN and forwards the print job to the spooling server; the printer polling device is located at and in communication with a second local area network; and the spooling server is located outside of the first and second LANs (col. 1, lines 12-17).

As to claim 11, Newton teaches that the print job source communicates with the spooling server via a first gateway firewall which controls access to the first LAN; and the printer polling device communicates with the spooling server via a second gateway firewall which controls access to the second LAN (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines 32-35).
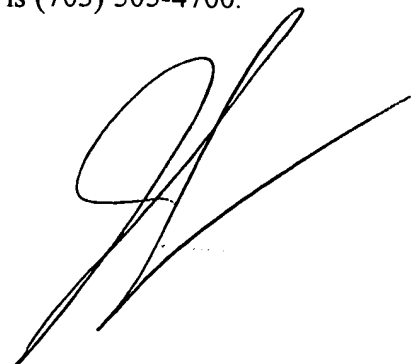
As to claims 52-56, combination of Savitzky and Pearson teaches the apparatus claims for performing the method claims 7-11.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Aug. 24, 2002